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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/623,181	12/12/2000	John Edward Andrew Shaw	20-954	9642

7590

09/17/2002

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EXAMINER

ALEXANDER, LYLE

ART UNIT	PAPER NUMBER
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1743

DATE MAILED: 09/17/2002

7

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-7

# Office Action Summary

Application No.

09/623,181

Applicant(s)

SHAW, JOHN EDWARD ANDREW

Examiner

Lyle A Alexander

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1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_ .
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_ .  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_ .
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ . 6) ☐ Other: \_\_\_\_ .

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***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-8,10-33 and 36-48 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Burns et al.(USP 6,379,929).

Burns et al. teach a device that employs meltable materials to control fluid flow. Burns teaches the use of hydrophobic material.

Claims 1-7,12,18-31,34,36-43 and 45-48 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Gubinski et al.

Gubinski et al. teach a device having multiple chambers employing a water expandable polymer sealing means. Gubinski et al. teach coating the inside of the device with carboxymethyl cellulose which has been read on the claimed hydrophilic compound.

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***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 9 and 34-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burns et al. in view of Jones.

See Burns et al. supra.

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Burns et al. are silent to the mechanically deformable material being mechanically deformable or the use of a polymer.

Jones teaches in column 1 an elastomeric control valve has the advantages of acceptable accuracy, leak resistant and very easy to manufacture and service. Jones further teaches polymeric compounds, such as rubbers, may be used to create the valve.

The court decided In re Boesch (205 USPQ 215) optimization of a result effective variable is ordinarily within the skill of the art. A result effective variable is one that has predictable and well known results.

It would have been within the skill of the art to modify Burns et al. in view of Jones and use a polymer control valve to gain the above advantages as optimization of a result effective variable.

Burns et al. in view of Jones is silent to the specifically claimed polypropylene polystyrene polymer.

The court decided In re Leshin (125 USPQ 416) "the selection of the plastic being on the basis of suitability of intended use would have been entirely obvious.

Polypropylene polystyrene polymers are well known in the art and have the advantages of being inexpensive to manufacture and are very inert.

It would have been within the skill of the art to further modify Burns et al. in view of Jones and use a polypropylene polystyrene polymer to gain the above advantages as based upon its suitability of intended use.

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Claims 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gubinski et al. in view of Jones.

Gubinski et al. is silent to the claimed mechanically deformable material being mechanically deformable or the use of a polymer.

Jones teaches in column 1 an elastomeric control valve has the advantages of acceptable accuracy, leak resistant and very easy to manufacture and service. Jones further teaches polymeric compounds, such as rubbers, may be used to create the valve.

The court decided In re Boesch (205 USPQ 215) optimization of a result effective variable is ordinarily within the skill of the art. A result effective variable is one that has predictable and well known results.

It would have been within the skill of the art to modify Gubinski et al. in view of Jones and use a polymer control valve to gain the above advantages as optimization of a result effective variable.

Claim 35 rejected under 35 U.S.C. 103(a) as being unpatentable over Gubinski et al.

Gubinski et al. is silent to the specifically claimed polypropylene polystyrene polymer.

The court decided In re Leshin (125 USPQ 416) "the selection of the plastic being on the basis of suitability of intended use would have been entirely obvious.

Polypropylene polystyrene polymers are well known in the art and have the advantages of being inexpensive to manufacture and are very inert.

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It would have been within the skill of the art to further modify Burns et al. in view of Jones and use a polypropylene polystyrene polymer to gain the above advantages as based upon its suitability of intended use.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lyle A Alexander whose telephone number is 703-308-3893. The examiner can normally be reached on Monday, Wednesday and Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 703-308-4037. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9319 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.



Lyle A Alexander  
Primary Examiner  
Art Unit 1743

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September 13, 2002